

Appl. No. 09/855,329
Atty Docket No. 8086
Response dated September 7, 2004
Reply to Office Action dated May 4, 2004

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REMARKS

Claims 1, 4, 5, 9-17, 20, 21, and 25-26 are pending in the application for the Examiner's review and consideration. Claims 2-3, 6-8, 18-19, and 22-24 have been canceled. Claim 1 was amended to substantially include a limitation from original claim 4. Claim 5 was amended to remove alpha-cyclodextrin derivatives. Claim 16 was amended to substantially include a limitation from original claim 20. Claim 21 was amended to remove alpha-cyclodextrin derivatives. Claims 4, 9 and 25 were amended to correct their dependencies.

ALLOWABLE SUBJECT MATTER

Applicants wish to thank the Examiner for indicating the allowability of claims 12-15 and 20.

CLAIM REJECTIONS UNDER 35 U.S.C. §112

Claim 11 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite regarding the term "derivative." Applicants respectfully traverse the rejection. Applicants respectfully contend that derivatives of cyclodextrins are clearly defined in Applicants specification. See page 5, line 6 to page 6, line 3 of the specification. One skilled in the art will understand the term "cyclodextrin derivative" based on the definition in the specification. Therefore, Applicants request that this rejection be reconsidered and withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claims 1 and 5

Claims 1 and 5 have been rejected under 35 U.S.C. §102(b) as being allegedly anticipated by WO 96/04937 to Trinh *et al.* ("Trinh"). Applicants respectfully traverse this rejection since the claims, as currently amended, are not anticipated by the Trinh reference.

Example VIII of the Trinh reference discloses a mixture of hydroxypropyl alpha-cyclodextrins and hydroxypropyl beta-cyclodextrins having an average degree of substitution of about 4.9. Applicants' amended Claim 1 requires that, when present, the hydroxyalkyl cyclodextrin has an average degree of substitution of less than about 4.5. This

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low average degree of substitution is not disclosed by the Trinh reference. Regarding Claim 5, the claim no longer includes alpha-cyclodextrin derivatives. Thus, Trinh does not disclose each and every limitation of either Claim 1 or Claim 5. Because each and every element of the claim has not been disclosed in a single prior art reference, Applicants respectfully request that the rejection made under 35 U.S.C. §102(b) be reconsidered and withdrawn.

Claims 16, 17 and 21

Claims 16, 17 and 21 have been rejected under 35 U.S.C. §102(b) as being allegedly anticipated by WO 96/04937 to Trinh *et al.* ("Trinh"). Applicants respectfully traverse this rejection since the claims, as currently amended, are not anticipated by the Trinh reference.

Example VIII of the Trinh reference discloses a mixture of hydroxypropyl alpha-cyclodextrins and hydroxypropyl beta-cyclodextrins having an average degree of substitution of about 4.9. Applicants' amended Claim 16 requires that, when present, the hydroxyalkyl cyclodextrin has an average degree of substitution of less than about 4.5. This low average degree of substitution is not disclosed by the Trinh reference. Claim 17 is dependent from claim 16 and therefore incorporates the limitations of claim 16. Regarding Claim 21, the claim no longer includes alpha-cyclodextrin derivatives. Thus, Trinh does not disclose each and every limitation of any of Claims 16, 17 and 21. Because each and every element of the claim has not been disclosed in a single prior art reference, Applicants respectfully request that the rejection made under 35 U.S.C. §102(b) be reconsidered and withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 10 and 26 have been rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over WO 96/04937 to Trinh *et al.* ("Trinh"). Applicants respectfully traverse this rejection. The reference does not establish a *prima facie* case of obviousness since it does not teach or suggest all of Applicants' claim limitations (see MPEP 2143.03). Specifically, the Trinh reference does not teach or suggest a hydroxyalkyl cyclodextrin having an average degree of substitution of less than about 4.5. Therefore, a *prima facie* case of obviousness has not been established.

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As stated above, the Trinh reference discloses a mixture of hydroxypropyl alpha-cyclodextrins and hydroxypropyl beta-cyclodextrins having an average degree of substitution of about 4.9. Applicants' Claim 10 (by its' dependency to claim 1) and Claim 26 (by its' dependency to claim 16) requires that, when present, the hydroxyalkyl cyclodextrin has an average degree of substitution of less than about 4.5. This low average degree of substitution is not taught or suggested by the Trinh reference. Since the Trinh reference does not teach or suggest a hydroxyalkyl cyclodextrin having an average degree of substitution of less than about 4.5, a *prima facie* case of obviousness has not been established. As a result, Applicants contend that their claimed inventions are novel and unobvious and that the rejection under 35 U.S.C. 103(a) should be withdrawn.

CONCLUSION

In view of the foregoing amendments and accompanying remarks, reconsideration of the application and allowance of claims 1, 4, 5, 9-17, 20, 21 and 25-26 are respectfully requested. Please charge any required fees to Procter & Gamble Deposit Account No. 16-2480.

Respectfully submitted,

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